

[SEE SIGNATURE BLOCKS FOR COUNSEL]

**UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION**

**SOFTWARE RIGHTS ARCHIVE, LLC**

**Plaintiff,**

**v.**

**GOOGLE, INC., AOL LLC, YAHOO! INC.,  
IAC SEARCH & MEDIA, INC., and LYCOS  
INC.,**

**Defendants.**

**GOOGLE INC., AOL LLC, YAHOO! INC.,  
IAC SEARCH & MEDIA, INC., and LYCOS  
INC.,**

**Counter-Claimants,**

**v.**

**L. DANIEL EGGER, SOFTWARE RIGHTS  
ARCHIVE LLC, and SITE TECHNOLOGIES,  
INC.,**

**Counter-Defendants.**

**No. C-08-03172 RMW**

**No. C-10-03723 RMW**

**SOFTWARE RIGHTS ARCHIVE,  
LLC'S MOTION TO COMPEL  
LELAND STANFORD JUNIOR  
UNIVERSITY TO RESPOND  
FULLY TO RULE 45 SUBPOENA**

**DATE: December 14, 2010**

**TIME: 10:00 AM**

**CTRM: 5, 4<sup>th</sup> Floor**

**JUDGE: Hon. Patricia V. Trumbull**

Software Rights Archive, LLC ("SRA") moves to compel Leland Stanford Junior University ("Stanford") to respond fully to SRA's Rule 45 Subpoena requesting documents.

SRA'S Motion to Compel Leland Stanford Junior University  
to Respond Fully to Rule 45 Subpoena  
CASE NO. 08-CV-3172-RMW-PVT and 10-CV-3723-RMW-PVT

**I. FACTS**

On July 1, 2010, SRA served Stanford with a subpoena for documents. *See Exhibit 1.* The subpoena contained seven specific requests, the first five of which related to five patents assigned to Stanford by Google employees, and all of which explicitly cite at least one of the three Egger patents-in-suit. The sixth request sought documents discussing Mr. Egger, his patents, patent applications and publications. Finally, the seventh targeted request related to agreements between Stanford and Google and its co-founders Lawrence Page and/or Sergey Brin.

Prior to serving the subpoena, SRA's counsel tried to contact Ms. Lauren K. Schoenthaler, who had been identified as the appropriate attorney in Stanford's legal department, to discuss the outlines of the proposed subpoena, to determine whether any agreements could be reached on the scope of the subpoena, and whether Stanford would accept service without further delay and expense. Neither Ms. Schoenthaler nor any other Stanford representative ever responded, so SRA effected service of the subpoena. SRA's counsel made another attempt to discuss the subpoena with Stanford's in-house counsel after receiving confirmation that the subpoena had been served. Again, SRA received no response.

On July 15, 2010, Stanford responded, represented by the same counsel that also represent Google and AOL in this suit. Stanford served multiple objections to the subpoena, essentially objecting to all of the requests on various boilerplate grounds, and stating that "subject to" its multiple objections it would produce "available, non-public, non-privileged documents." *See Exhibit 2.* No explanation was given for Stanford's interpretation of the phrase.

Finally, after months went by without actual production, SRA's counsel indicated that a motion to compel was imminent. Stanford thereupon produced 109 pages, unaccompanied by a

1 privilege log. SRA moves to compel a complete production on all seven requests.<sup>1</sup>

2 **II. Stanford's Objections are Not Valid because the Requested Discovery is Relevant.**

3 This case involves search technology. Stanford owns search technology and licenses it to  
 4 Google. SRA contends that Google's activities also infringe three Egger patents-in-suit. The  
 5 documents sought relate directly to critical issues in the suit. For example, during the application  
 6 process for one of the Stanford patents (assigned to Stanford by Google founder Larry Page), the  
 7 Patent Office cited the Egger '494 patent-in-suit as prior art justifying rejection of the  
 8 application. The application had to be revised and narrowed to pass muster; it ultimately issued  
 9 as U.S. Patent No. 6,285,999 ("the '999 Patent). The '999 Patent and four other patents assigned  
 10 to Stanford all cite the Egger '494 patent-in-suit; those five patents are the basis of the first five  
 11 Document Requests. The sixth Document Request asks for information relating to Daniel Egger,  
 12 his patents, and publications. Finally, the seventh Document Request seeks all documents and  
 13 things concerning any agreements between Stanford and Google, and/or its founders Larry Page  
 14 and Sergey Brin. In particular, the seventh Request is designed to obtain the agreements and the  
 15 documents indicating the value and importance the parties to those agreements placed upon the  
 16 search technology that was conveyed and licensed back through those agreements—the same  
 17 technology which, as practiced by Google, is accused of infringement in this suit..  
 18

19  
 20 Unfortunately, Stanford objected to all of the document requests on invalid grounds such  
 21 as relevance. It also stated that any production was "subject to" the objections. Ultimately, in  
 22 providing just 109 pages of documents, Stanford provided no internal memos, no evaluations of  
 23 the alleged improvements of these five patents over the prior art, including the Egger patents-in-  
 24

25 <sup>1</sup> SRA's undersigned counsel conferred with Stanford's counsel a second time on November 4,  
 26 2010, this time outlining specific defects in the objections and obvious gaps in the production.  
 27 Because of the long-outstanding requests, the breadth of the objections, and the extremely  
 28 skimpy production, SRA has been forced to set this matter for hearing. If the parties reach any  
 agreements in the next five weeks, SRA will of course notify the Court.

1 suit, no letters or other correspondence, nor any other information on the prosecution of the five  
 2 patents that cite the Egger patents-in-suit.

3 Such information is highly relevant. It relates to the understanding and appreciation of  
 4 those practicing in the field, including Google principals such as Larry Page, of the significance  
 5 of the Egger patents-in-suit. Information on the prosecution of the patents should also provide  
 6 information relevant to secondary considerations. The requested information should also provide  
 7 valuable evidence relating to the state of mind of Google principals and, in particular, to willful  
 8 infringement. It also should provide evidence of the immense value of the infringing  
 9 technology—evidence to be presented to the jury on damages.

10 Request No. 7, if answered faithfully, without evasions, is expected to provide  
 11 information relevant to damages. Essentially, the Stanford/Google arrangement involved a  
 12 license from Stanford to Google of search technology (which Stanford owned because it was  
 13 developed at Stanford), with Stanford receiving cash plus [REDACTED] interest in Google. *See*  
 14 Exhibit 3 at STF 0000028.<sup>2</sup> Subsequently, Stanford gave [REDACTED]  
 15 [REDACTED]. *See* Exhibit 4. According to public information, at the time of Google's initial  
 16 public offering, Stanford's remaining [REDACTED] interest in Google was worth approximately \$195  
 17 million. *See* Exhibit 5. However, despite this immense sum, Stanford has produced no internal  
 18 memoranda, no evaluations of the value of the Google search technology which it owns, no  
 19 letters or other correspondence to or from valuation experts, no accounting of its proceeds from  
 20 royalties or Google stock sales, nor any other information relating to the value of Google's  
 21 search technology. It defies belief that Stanford has never written a single word or created a  
 22  
 23  
 24

25 <sup>2</sup> Exhibit 3, part of Stanford's limited production, is an example of a license agreement that  
 26 should also have been produced by Google over two years ago. It is one of thousands of  
 27 documents that Google has withheld. Google's misconduct, which has forced SRA to file  
 28 multiple motions to compel, demonstrates why this lawsuit merits "exceptional case" status  
 under 35 U.S.C. § 285.

1 single document, other than the license agreements themselves, discussing the value of that  
2 technology (and it similarly defies belief that Stanford would have destroyed all those  
3 documents). Similarly, it defies belief that there are no documents whatsoever regarding the  
4 negotiation and amendment of any of these agreements (in all, there are at least [REDACTED] agreements  
5 or amendments thereto beginning in 1998), not even an explanation as to why, when or how  
6 Stanford's ownership stake in Google was set at [REDACTED]. It defies belief that there are no  
7 documents as to how Stanford ever valued its interest in Google, which it received in return for  
8 licensing search technology back to Google. Similarly, although Stanford has produced one  
9 document showing that [REDACTED]  
10 [REDACTED]  
11 [REDACTED]  
12 [REDACTED] nor any  
13 documents relating to the decision. The value of the compensation provided by Google to  
14 Stanford for the search technology license is highly relevant. All of these documents are  
15 responsive to Request No. 7 and relevant for discovery purposes.

16 Finally, Stanford's comment that it will produce only non-public documents leaves large  
17 gaps in the production. SRA fears that its view of what is "public" and Stanford's view are quite  
18 different. If Stanford has responsive documents, they should be provided. SRA should not be  
19 forced to search for documents readily available to Stanford.  
20

### 21 **III. Conclusion**

22 SRA is entitled to production of all requested documents. The objections, other than  
23 attorney-client privilege and work product, should be overruled, and Stanford ordered to produce  
24 all responsive documents within ten days, along with a privilege log.  
25  
26  
27  
28

Respectfully submitted,



Lee L. Kaplan (Texas Bar No. 11094400)  
Jeffrey A. Potts (Texas Bar No. 00784781)  
Raj Duvvuri (Texas Bar No. 24054185)  
(admitted *pro hac vice*)  
700 Louisiana Street, Suite 2300  
Houston, Texas 77002  
Telephone: (713) 221-2300  
Facsimile: (713) 221-2320  
Email: lkaplan@skv.com

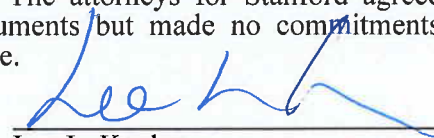
Jay D. Ellwanger (California Bar No. 217747)  
Victor G. Hardy (Texas Bar No. 00790821)  
Chester J. Shiu (Texas Bar No. 24071126)  
(admitted *pro hac vice*)  
DiNovo Price Ellwanger & Hardy LLP  
7000 North MoPac Expressway  
Suite 350  
Austin, Texas 78731  
Telephone: (512) 539-2630  
Facsimile: (512) 539-2627  
Email: jellwanger@dpelaw.com

Thomas F. Smegal, Jr. (California Bar No. 34,819)  
One Sansome Street, 35th Floor  
San Francisco, CA 94104  
Telephone: (415) 217-8383  
Facsimile: (415) 399-0593  
Email: tomsmegal@smegallaw.com

Attorneys for Software Rights Archive, LLC

**CERTIFICATE OF CONFERENCE**

SRA's counsel has complied with the meet and confer requirement in Local Rule CV-7(h). The personal conferences required by the Rule have been conducted. The date of the last conference was November 4, 2010. The attorneys for Stanford agreed to consider the requests and the potentially missing documents but made no commitments. There remain multiple open issues for this Court to resolve.



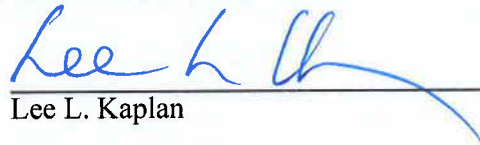
Lee L. Kaplan

SRA'S Motion to Compel Leland Stanford Junior University  
to Respond Fully to Rule 45 Subpoena  
CASE NO. 08-CV-3172-RMW-PVT and 10-CV-3723-RMW-PVT

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the above and foregoing instrument has been forwarded to all counsel of record pursuant to Federal Rules of Civil Procedure on this the 5<sup>th</sup> day of November, 2010.

  
\_\_\_\_\_  
Lee L. Kaplan

SRA'S Motion to Compel Leland Stanford Junior University  
to Respond Fully to Rule 45 Subpoena  
CASE NO. 08-CV-3172-RMW-PVT and 10-CV-3723-RMW-PVT